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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,332

03/29/2004

Clare J. Watkins

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EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,332	<b>Applicant(s)</b> WATKINS ET AL.	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 220-278 is/are pending in the application.
- 4a) Of the above claim(s) 220-244, 247, 250, 252, 254-272 and 276 are is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 245,246,248,249,251,253,273-275,277 and 278 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 220-278 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of compound 13 on page 60 of the specification in the reply filed on 7 December 2006 is acknowledged. Claims 245, 246, 248, 249, 251, 253, 273, 274, 275, 277 and 278 are readable thereon. Claims 220-244, 247, 250, 252, 254-272 and 276 are held withdrawn from consideration as being drawn to a non-elected invention.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: there appears to be an error in the Oath since both the parent application and the PCT have the same filing date.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1621

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 245, 246, 248, 249, 251, 273, 274, 275, 277 and 278 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohtani et al (US 5,534,654 07-1996). Ohtani discloses (Column 28, lines 25-30), for example the compound (I-18) which corresponds to an aromatic ring isomer of the first listed compound of claim 253. Ohtani also discloses (Column 37, lines 5-15) the compound (I-28) in which Y<sup>3</sup> is -CH=CH-. Ohtani therefore anticipates claims 245, 246, 248, 249, 251, 273, 274, 275, 277 and 278.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 245, 246, 248, 249, 251, 253, 273, 274, 275, 277 and 278 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani et al (US 5,534,654 07-1996).

Instantly claimed are compounds of the formula  $Cy-L^3-Ar-Y^3-C(O)NH-Z$  where the variables are defined in the claims.

Ohtani teaches (Column 28, lines 25-30), for example the pharmaceutically active compound (I-18) which corresponds to an aromatic ring isomer of the first listed compound of claim 253. Ohtani also teaches (Column 37, lines 5-15) the compound (I-28) in which  $Y^3$  is  $-CH=CH-$ .

The difference between the instantly claimed compounds and those taught by Ohtani is that the instantly claimed compounds have a 1,4- relationship of substituents  $L^3$  and  $Y^3$  about Ar while those exemplified by Ohtani have 1,2- and 1,3- relationships of  $L^3$  and  $Y^3$  about Ar.

Ohtani, however, generically teaches (Column 2, lines 5-52) all orientations of substituents about the central aromatic ring.

One of ordinary skill in the art would therefore have been motivated to modify the compounds specifically exemplified by Ohtani according to his generic teaching. Because such modification is suggested by Ohtani there would have been a reasonable expectation for. The Examiner also notes that, absent Ohtani's teaching, such modification of the compounds would have been motivated by the expectation of similar properties for aromatic ring isomers and that there would also have been a reasonable expectation for success.

Thus the instantly claimed compounds would have been obvious to one of ordinary skill in the art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 1621

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 245, 246, 248, 249, 251, 273, 274, 275, 277 and 278 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of U.S. Patent No. 6,888,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent teaches (Claim 37) a compound which corresponds to compound instantly claimed in generic form in which  $Y^3$  is  $-CH=CH-$ .

The difference between the instantly claimed compounds and those taught by the patent is that the instantly claimed compounds have a 1,4- relationship of substituents  $L^3$  and  $Y^3$  about Ar while that exemplified by the patent has a 1,3- relationship of  $L^3$  and  $Y^3$  about Ar.

One of ordinary skill in the art would therefore have been motivated to modify the compound specifically exemplified by the patent by the expectation of similar properties for aromatic ring isomers and that there would also have been a reasonable expectation for success.

Thus the instantly claimed compounds would have been obvious to one of ordinary skill in the art.


**Conclusion**

6. Claims 220-278 are pending. Claims 245, 246, 248, 249, 251, 253, 273, 274, 275, 277 and 278 are rejected. Claims 220-244, 247, 250, 252, 254-272 and 276 are held withdrawn from consideration as being drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
PAULA A. ZUCKER, PH.D.  
PRIMARY EXAMINER  
